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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) ROC920010117US1 | |
|---|--|---|---------------------------------|
| I hereby certify that this correspondence is being facsimile transmitted to fax number (571) 273-8300 to the attention of Examiner Kristie D. Shingles on <u>22 Aug 05</u> | | Application Number 09/886,324 | Filed June 21, 2001 |
| Signature <u></u> | | First Named Inventor Richard Alan Diedrich | |
| Typed or printed Name Randol W. Read | | Art Unit 2141 | Examiner Kristie D. Shingles |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number 43,878</p> <p> _____ Signature</p> <p>Randol W. Read _____ Typed or printed name</p> <p>(713) 623-4844 _____ Telephone number</p> <p><u>22 Aug 05</u> _____ Date</p> | | | |
| <input type="checkbox"/> *Total of _____ forms are submitted. | | | |

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MPS Ref. No.: IBMK10117

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 22 2005

In re Application of:

DIEDRICH et al.

Serial No.: 09/886,324

Confirmation No.: 5395

Filed: June 21, 2001

**For: MAPPING PHYSICAL
LOCATIONS TO WEB SITES**

www.pearsoned.com

Group Art Unit: 2141

Examiner: Kristie Shingles

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to fax number 571-273-8300 to the attention of Examiner Kristie Shingles, on the date shown below:

Date _____

Randol W. Read

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with the Pre-Appeal Brief Request for Review filed herewith, Applicants request a Panel review of the Final Rejection in this matter. Although the remarks herein are focused on a specific issue raised by the rejection, nothing in this paper is meant to limit the scope of any arguments, either factual or legal, that Applicants may later present in a full appeal brief.

QUESTION FOR REVIEW

Applicants request a pre-appeal conference review to address the significance of an admitted distinction between references cited by the Examiner and the present claims. In a Final Office Action dated May 20, 2005, the Examiner premises a rejection on a reference that teaches deriving an indicia of geographic location from a query. In

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contrast, Applicants claim a query that includes an express statement of geographic location information. Therefore, the Applicants and the Examiner agree as to the teaching of the reference. Applicants submit that on the basis of this mutual understanding, the present claims are necessarily allowable.

REMARKS

In response to Applicants' arguments made in response to the Final Office Action, the Examiner states: "Applicant argues in substance, that prior art reference, *Anderson*, et. al (USPN 6,684,250) does not teach a query that explicitly contains a network address and geographic location information." See *Advisory Action*. More specifically, Applicants assert that *Anderson* fails to disclose a query that explicitly contains geographic location information.

The Examiner concedes that *Anderson* fails to teach a query that includes the geographic location information in the *Advisory Action*, stating: "*Anderson* et al., teach **associating** network addresses with geographic locations **in response to query** (Abstract), wherein the query with its **associated** user machine IP address **yields** the geolocation information of the user machine to the data collection agents (col. 9 lines 15-31)." See *Advisory Action*.

Thus, *Anderson* teaches a method for **deriving** a geographic location from a network address associated with the query. In contrast, however, Applicants claim a query for a network address (e.g., a website URL) that has some correspondence with the geographic location information included in the query. The network address (e.g., website URL), however, is returned in response to the query and geographic location information; the "user machine IP address" is irrelevant, for the elements recited by Applicants' claims.

Clearly, the Examiner appreciates that the query (as disclosed in *Anderson*) does not **include** geographic location information, and that *Anderson* teaches a method that includes the step of **deriving** some indicia of geographic location information from the requester's originating network address. Despite these admitted distinctions, claims 29 and 34 (along with their respective dependent claims) stand rejected under 35 U.S.C. §

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102(e). Applicants submit that maintaining this rejection over this admitted distinction is a clear legal error, and respectfully request the Panel order that the rejection be withdrawn and the claims proceed to allowance.

Similarly, the Examiner argues that *MacPherson* (U.S. 6,845,400) discloses a "method and an apparatus operates to associate a geographic location associated with a network address." See *Advisory Action*. Claims 1, 14, 24, 29, and 34 stand rejected under 35 U.S.C. § 103 over a combination of *Anderson* and *MacPherson*. Both the Examiner and the Applicants appear to agree on a distinction between the references and the claims being rejected; namely, that the query of *Anderson* and *MacPherson* does not include geographic location information, and instead that the references disclose some mechanism for a best guess at geographic location information derived from network communications data.

Since a *prima facie* case of obviousness requires that the combination of references teach every limitation of the rejected claim, Applicants submit that a *prima facie* case has not been established.

Because the respective claims and references proceed using different steps, using different information to obtain different results, Applicants submit that maintaining the rejection over these admitted distinctions is a clear legal error, and respectfully request the Panel order that the rejection be withdrawn and the claims proceed to allowance.

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Conclusion

Applicants believe that the foregoing discussion demonstrates the patentability of the present claims over the cited references. Accordingly, Applicants request that the Panel vacate the rejection and remand the matter to the Examiner with instructions to allow the present claims.

Respectfully submitted,



Randol W. Read
Registration No. 43,876
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants